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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,172	10/23/2003	Joseph Anthony Griffiths	1315-18	8359
7590	11/15/2005			
David M. Carter Carter, DeLuca, Farrell & Schmidt, LLP Suite 225 445 Broad Hollow Road Melville, NY 11747			EXAMINER PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 11/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/692,172	GRIFFITHS, JOSEPH ANTHONY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kuo-Liang Peng	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/26/04 IDS.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. It is noted that the foreign application, GB 0224674.2, has not been received yet.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (US 6 733 893).

Suzuki discloses a method of coating a silicone rubber article with a butyl rubber material. The surface of the silicone rubber article can be pre-treated with corona discharge. (col. 2, lines 27-58, col. 5, line 58 to col. 6, line 51, col. 8, lines 18-36 and Examples) The butyl rubber layer reads on Applicants butyl rubber

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layer. Therefore, it inherently possesses NBC resistance properties. *In re Best*, 195 USPQ 430 (CCPA 1977). The butyl rubber material can be sprayed on the silicone rubber article. (col. 8, lines 28-34)

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 6 733 893).

Suzuki discloses a method of coating a silicone rubber article with a butyl rubber material, *supra*, which is incorporated herein by reference.

For Claim 8, it is known in the art that before corona discharge treatment, the substrate surface should be thoroughly cleaned. Suzuki teaches a method of cleaning the surface of the silicone rubber article by solvent washing. (col. 8, lines 18-27) Therefore, it would have been obvious to one of ordinary skill in the art at

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the time of the invention was made to clean the surface of the silicone rubber article utilizing a solvent wash such as soapy water wash because a soapy water is the most common, least expensive and non-toxic solvent system for cleaning. Especially, Applicants do not show the criticality of the specific use of soapy water. For Claims 10-11 and 15-16, Suzuki further teaches that the butyl rubber coating will impart the resistance of liquid or gas permeability of the silicone rubber article. (col. 8, lines 48-56) In addition, the thickness of the coating will affect such a permeability. In other words, the coating thickness is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a plurality of coatings through routine experimentation in order to achieve a desired permeability resistance. See MPEP 2144.05 (II). Suzuki further teaches curing the butyl rubber coating together with the silicone rubber article at elevated temperature. Note that it is obvious to use a preheated oven for the curing in order to cure the butyl rubber coating and the silicone rubber article in a controlled environment and at the right temperature starting from the very beginning. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to allow each coat to dry before the application of a subsequent coat in order to have a better control of the thickness, etc. For Claims 12-14 and 17-19, Suzuki is silent

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on curing temperature and curing time for the butyl rubber material and the silicone rubber article set forth in the instant claims. However, the curing temperature will affect the curing rate and vice versa. In other words, the curing temperature and the curing time are Result-Effective variables. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to cure the butyl rubber material and the silicone rubber article at whatever temperature or in whatever time through routine experimentation in order to achieve a desired curing process. Especially, Applicants do not show the criticality of the curing temperature and the curing time. See MPEP 2144.05 (II).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

November 10, 2005

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712